

**REMARKS**

Claims 1 through 28 are pending in this application. Claims 10 and 24 are amended in several particulars for purposes of clarity in accordance with current Office policy, to assist the examiner and to expedite compact prosecution of this application. The Applicant appreciates the Examiner's indication of allowance concerning claims 19-21 and 23-28 and the allowability of claim 24.

**I. DRAWING**

The Examiner objected to the "the mail server" not being shown in the figures. Therefore, Figure 1 has been updated to include the mail server which is supported by the specification (*e.g.*, paragraph 34). According to 37 CFR 1.121 Manner of making amendments in application:

(d) *Drawings*. Application drawings are amended in the following manner: Any change to the application drawings must be submitted on a separate paper showing the proposed changes in red for approval by the examiner. Upon approval by the examiner, new drawings in compliance with §1.84 including the changes must be filed.

Therefore, according to 37 CFR §1.121, the change to drawing has been submitted on a separate sheet showing the proposed changes in red for approval by the examiner. Upon approval by the examiner, new drawings in compliance with §1.84 including the changes will be filed.

Accordingly, a letter to the Office Draftsman accompanies this response. Indication in

subsequent Office correspondence of the acceptance to the drawing corrections proposed in the letter, is requested to enable applicant to timely arrange for the corrections to be made prior to the date for payment of any issue fee. No new matter was added since the amendment to the drawing is supported by the specification.

The specification was also updated to include the reference number 23 for the mail server included in figure 1.

## **II. SPECIFICATION**

The Examiner objected to the language in page 3, line 18 where “an” should be corrected to “and.” The typographical error was corrected accordingly.

## **III. CLAIM OBJECTIONS**

The Examiner stated that Claim 24 was objected to because of the following informalities: The noun "letters" on page 23, line 12, should not be plural. Appropriate correction is required. The claim was corrected according to the Examiner's advice.

## **IV. CLAIM REJECTIONS - 35 U.S.C. § 112, FIRST PARAGRAPH**

The Examiner stated that Claim 22 is rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner stated that the claim contains subject matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner stated that in line 4 of page 22, K is set to the number of registered accounts, and given a range between 1 and the number of accounts, whereas in the specification, in line 10-11 of page 12, K is set as the number of registered accounts, and given a range between 1 and the number of registered accounts. The Examiner reasons that the number of accounts is a superset of the number of registered accounts, and therefore, not equivalent.

However, it is well settled that the disclosure in an originally filed claim can be used as part of the disclosure as clearly mentioned in MPEP §608.04, "In establishing a disclosure, applicant may rely not only on the specification and drawing as filed but also on the original claims if their content justifies it." Therefore, contrary to Examiner's conclusion, the Applicant did have possession of the claimed invention. Therefore, since the language mentioned by the Examiner was included in the originally filed claim 22, it can be used as part of the disclosure and support of claim 22.

#### **V. CLAIM REJECTIONS - 35 U.S.C. § 112, SECOND PARAGRAPH**

The examiner rejects Claims 13 and 16 under the second paragraph of 35 U.S.C. §112 for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner stated that Claims 13 and 16 recite the limitation "the group" on page 19 and 20, respectively. According to the Examiner there is insufficient antecedent basis for this limitation in the claim.

Respectfully, the language the Examiner is citing is "selected from the group consisting of a keypad and a mouse" in claim 13 and "selected from the group consisting of parallel port and universal bus" is well settled as the text for a markush type claim language. Therefore, the "the group" does not have to be changed to "a group". The USPTO recommends the language in MPEP§2173.05(h), as "being "selected from the group consisting of A, B and C." See *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925)."

## **VI. CLAIM REJECTIONS - 35 U.S.C. § 102**

Claims 1, 2, 5, 8-10, 12-15, and 17, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by No. 5,521,719 to Yamada. The Applicant respectfully traverses.

No claim is anticipated under 35 U.S.C. §102 (b) unless all of the elements are found in exactly the same situation and united in the same way in a single prior art reference. As mentioned in the **MPEP §2131**, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Every element must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (CAFC 1989). The identical invention must be shown in as complete detail as is contained in the patent claim. *Id.*, "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970), and MPEP 2143.03.

The Examiner states that Yamada includes a mail server which is a telephone network in col. 2, lines 15-20. However, looking at col. 2, lines 15-20, the telephone network is stated as being a PSTN which is a public switched telephone network and clearly not a mail server. As mentioned above, every element must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (CAFC 1989).

The Examiner stated that the mail server has a unique address (column 13, lines 45-50), however, looking at lines 45-50 of column 13 does not include the mail server having a unique address but only mentions the network control unit "performing line control so as to establish a telephone circuit to be used for the facsimile communication." Clearly this explanation does not disclose a unique address for the mail server but only a connection state.

The Examiner stated that Yamada discloses a display unit for displaying information extracted from the image and character data (Fig. 10, element 135 and column 15, lines 20-25). However, looking at the selected text of Yamada, it states that element 135 is a personal computer. Furthermore, in col. 15, lines 20-25 only state that a number 04 procedure process to output the relevant facsimile data as electronic mail to the PC 135 connected to the LAN. However, Yamada is not disclosing as in the present invention that the extracted image and character data is displayed on the display unit, but only states that the facsimile data as electronic mail is sent to the personal computer which does not have to display the information.

The Examiner stated that Yamada discloses a user interface outputting a display request signal when an authorized user requests to view a letter addressed to the authorized user and outputting an account control signal having information selected by the authorized user from the displayed information (Fig. 9, element 115 -116 and column 13, lines 28-50 and Fig. 10, element 135). However, looking at col. 13, lines 28-50, the operation input unit 115 includes various input keys and the operation display unit 116 displays the operational state of the apparatus 111. Furthermore, element 135 is only a personal computer connected through the local area network (LAN). However, nowhere in Yamada does it disclose the *user interface unit outputting a display requesting signal when an authorized user requests to view a letter addressed to the authorized user and outputting an account control signal having information selected by the authorized user from the displayed information*. Again, every element must be literally present, arranged as in the claim. As seen here, every element as arranged in the claim is not disclosed by Yamada.

The Examiner mentions that Yamada discloses a controller (Fig. 1, element 2 and 13) storing the image and character data received from electronic letter receiver in the letter storing unit. Display request, account control, and printer control signals will come over the bus (Fig. 9, element 111) and detected/responded by controller. However, element 2 is the system controller which is different from the element 12 which is a modem.

Furthermore, neither unit 2 or 12 is used for (1) *outputting the stored image and character data to the display unit in response to the display requesting signal*, (2) *reading image and character data selected from among the stored image and character data based on the account control signal*,

*from the letter storing unit, and (3) outputting the read image and character data together with a printing control signal as seen in the presently claimed invention.*

The controller 2 controls writing and/or reading of image data into/from floppy disk device 5 or hard disk drive 6 or 7 (col. 6, lines 5-7), controls the communication processors FCU (col. 6, lines 16-17), acts as a destination address determination means (col. 7, lines 59-61), however the controller 2 or the modem 12 do not disclose the above three limitations as arranged in the claims.

In reference to Claim 2, the Examiner stated that the letter storing unit is included within a personal computer (Fig. 10, element 135). However, earlier the Examiner stated that the letter storing unit were elements 5, 6 and 7 and nowhere in the Yamada does it show that elements 5, 6, 7 are *includes within* the personal computer 135. One cannot just mix indiscriminately different elements. The exact elements must be disclosed.

In reference to Claim 10, the Examiner states that Yamada discloses the letter storing unit being divided into a plurality of areas (Fig. 1, elements 5, 6, 7 and Fig. 9, elements 124 and 125). However, elements 5, 6, 7 are actual distinct storing units, 5 being a floppy disk drive, 6 and 7 being hard disk drives which are each capable of storing information but they are not areas of the storing unit that are divided to accommodate image and character data corresponding to an electronic letter addressed to a certain user. Yamada does not disclose the plurality of areas accommodating image and character data corresponding to an electronic letter addressed to *a certain user*.

Furthermore as seen in the amended claim 10, the data is not stored in the assigned area of

the user, the area being one of the plurality of areas divided in the letter storing unit.

In reference to Claim 12, the Examiner stated that Yamada discloses a display unit being a PC (Fig. 10, element 135) accessible to electronic letters obtained over a communication apparatus (Fig. 9, element 111) where image and character data are sent by a controller (Fig. 9, elements 112) to the user who has authority of the PC. However, nowhere in Yamada does it disclose concerning the user having *authority*. Authorization of a user is never mentioned in Yamada and therefore, the security feature of the present invention is lacking in Yamada.

## VII. REJECTION OF CLAIMS (35 U.S.C. § 103)

Claims 3, 4, 6, 7, 11, 16 and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable. The Applicant respectfully traverses.

According to MPEP 706.02(j), the following establishes a *prima facie* case of obviousness under 35 U.S.C. §103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or



to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

**A. Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over Yamada (U.S. Patent 5,521,719) in view of Tyson (www.howstuffworks.com). The Applicant respectfully traverses.**

First, any reference that is given, it must be shown that it predates at least the filing date of the present invention. It is not shown that Tyson predates the present invention.

Furthermore, just because Tyson teaches or suggest a flash memory does not mean that to should be combined with Yamada. The first point in MPEP 706.02(j) states that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat

patentability. *In re Dembiczak*, 175 F.3d 994, 50 USPQ.2d 1614 (Fed. Cir. 1999). The showing must be “clear and particular” without broad generalized conclusory statements. *Id.* There must be specific statements showing the scope of the suggestion, teaching, or motivation to combine the prior art references. *Id.* at 1000. There must be an explanation to what specific understanding or technical principle would have suggested the combination of references. *Id.* Respectfully, stating that to “obtain all the advantages of flash memory described in Tyson” is not a proper suggestion or motivation under the MPEP 706.02(j) because it is not sufficiently clear and particular.

Therefore, respectfully, this is an improper rejection.

**B. Claim 7 was rejected under 35 U.S.C. §103(a) as being unpatentable over Yamada in view of Tyson (www.howstuffworks.com). The Applicant respectfully traverses.**

Again, it is not shown that the disclosure in Tyson (www.howstuffworks.com) predates the filing date of the present invention.

By using www.howstuffworks.com, it seems that the Examiner is improperly taking the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability. *In re Dembiczak*, 175 F.3d 994, 50 USPQ.2d 1614 (Fed. Cir. 1999). The mentioning of some advantages in an EPROM in www.howstuffworks.com would not be proper motivation to combine the two references especially if it cannot be authenticated that the disclosure in www.howstuffworks predates at least the filing date of the present invention.

Therefore, respectfully, this is an improper rejection.

**C. Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over Yamada in view of the disclosure in the APC website. The Applicant respectfully traverses.**

Again, it is not shown that the disclosure in APC website predates the filing date of the present invention and therefore it is respectfully, an improper rejection. Respectfully, again, the Examiner is improperly taking the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability.

**D. Claim 13 was rejected under 35 U.S.C. §103(a) as being unpatentable over Yamada in view of www.webopedia. The Applicant respectfully traverses.**

Again, it is not shown that the disclosure in www.webopedia predates the filing date of the present invention and therefore it is respectfully, an improper rejection. Webopedia is only an online dictionary for present terms and does not predate the filing date of the present invention. Further, webopedia is merely giving a definition for a "password". Clearly this is not a proper reference against the present invention.

**E. Claim 16 and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Yamada in view of Tyson (howstuffworks.com) in further view of Brian(howstuffworks.com). The Applicant respectfully traverses.**

Again, it is not shown that the disclosure in howstuffworks.com predates the filing date of the present invention and therefore it is respectfully, an improper rejection. Furthermore the discrete units defined in howstuffworks.com do not properly give the motivation to combine. As mentioned in MPEP 706.02(j), "The teaching or

suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure." The Examiner mentioned that the motivation to combine is to prevent custom building a computer interface unit and be able to interconnect other devices that use parallel ports and USB interfaces. However, neither [www.howstuffworks.com](http://www.howstuffworks.com) or Yamada mention such motivations and therefore, the motivation to combine is improper.

**F. Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over Yamada.**

**The Applicant respectfully traverses.**

The Examiner has stated that at the time of the invention it would have been obvious to a person of ordinary skill in the art to only display information on a console as described by Yamada (Fig. 10, element 135) to someone who has the ability to login to the console, i.e., one who has the correct login and password. This, the Examiner states is especially the case since information on the apparatus described by Yamada has information from a plurality of electronic letter senders, many items that are probably information sensitive.

Respectfully, the Examiner has failed to provide a reference to teach or suggest all of the claimed elements. Yamada alone was not able to teach or suggest the elements in claim 3 and therefore, the Examiner resorted to the Examiner's personal knowledge.

Therefore, it is then the right of the Applicant to demand from the Examiner proof in terms of a reference or a sworn affidavit by the Examiner stating that the above is known in the art.

**G. Claim 4 was rejected under 35 U.S.C. §103(a) as being unpatentable over Yamada.**

**The Applicant respectfully traverses.**

The Examiner stated that at the time of the invention it would have been obvious to a person of ordinary skill in the art to display information such as the number of accounts of the users, the number of letters addressed to each account and the subjects of the letters on the display unit (Fig. 10, element 135). The Examiner further states that the user who has logged into the account can select the account and the subject header of the electronic letter to view the electronic letter. The Examiner has stated that this is how several ISP providers have setup their services where Cox Communications High Speed Internet Service is a good example.

Respectfully, the Examiner has failed again to provide a reference to teach or suggest all of the claimed elements. Yamada alone was not able to teach or suggest the elements in claim 4 and therefore, the Examiner again resorted to the Examiner's personal knowledge.

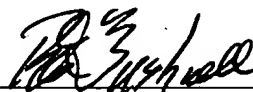
Therefore, it is then the right of the Applicant to demand from the Examiner proof in terms of a reference or a sworn affidavit by the Examiner stating that the above is known in the art.

In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the examiner is asked to contact the applicant's attorney.

No fee is incurred by this Amendment. Should there be a deficiency in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of

Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "R. E. Bushnell", is written over a horizontal line.

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